

There is no motivation within the prior art for the combination:

In his Response to Arguments, the Examiner recognizes that obviousness can only be established by combining references where there is some teaching, suggestion, or motivation to do so in the references themselves or in generally available knowledge. After acknowledging this requirement to show motivation, the Examiner suggests that motivation to combine the teaching of Keyworth et al. with that of Livingston exists "since [the combination] would allow users quickly to review and to change each individual page's attributes."

The Examiner is proposing that the motivation to combine Keyworth et al. with that of Livingston is present because the combination would allow users quickly to review and to change each individual page's attributes and would thereby provide a better result than would the primary reference alone. In effect, what the Examiner suggests is that the motivation for the modification is that it is an improvement over the primary reference. Expanding on that reasoning would lead one to the conclusion that the only combinations of prior art references that are non-obvious are those that would result in a device that does not work better than the primary reference alone.

Applicant proposes that the test for motivation is not merely that the combination would be an improvement over the primary reference, but that there was some explicit teaching or suggestion in art to motivate one of ordinary skill to combine elements so as to create same invention. This is even supported by the two court cases cited by the Examiner. *In re Jones*, 958 F.2d 347, 21 USPQ.2d 1941 (Fed. Cir. 1992), requires that the Examiner identify where the prior art provides a motivating suggestion for the modification. The Court held "Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so ... *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ.2d 1596, 1598-99 (Fed. Cir. 1988). "[at 1943]. "The prior art must provide one of ordinary skill in the art the motivation to make the proposed molecular modifications needed to arrive at the claimed compound. "[at 1944].

Moreover, the Courts have uniformly held that a modification is not obvious unless the prior art suggests the desirability for the modification, as for example, in the decision in *In re Fritch*, 922 F.2d 1260, 23 USPQ.2d 1780 (Fed. Cir. 1992), where the Court held:

"The mere fact that prior art may be modified to reflect features of claimed invention does not make modification, and hence claimed invention, obvious unless desirability of such modification is **suggested by prior art** ... "[at 1780] (Emphasis added)

"The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious **unless the prior art suggested the desirability of the modification**. *In re Gordon*, 733 F.2d at 902, 221 USPQ at 1127. "[at 1783] (Emphasis added)

Applicant believes that the motivational test applied by the Examiner is incorrect, and that there is no motivation to one skilled in the art to modify the subject matter of Livingston in view of the teachings of Keyworth et al. In the present application, it is not the prior art that suggests that combining Keyworth et al. with Livingston "would allow users quickly to review and to change each individual page's attributes" as suggested by the Examiner; but rather it is the specification of the present application that provides such teaching. "It is impermissible to use the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, *Supra*.

The references in combination do not disclose the claimed invention:

Assuming arguendo that the Keyworth et al. and Livingston might be capable of combination, there is at least one limitation in the claimed invention that is not disclosed by the references individually or in combination.

According to the Examiner, "Livingston does not disclose [that] the GUI displays more than one page representation simultaneously." The Examiner suggested that Keyworth et al. would provide the features missing from Livingston if the references were combined. However, Keyworth et al. also fail to disclose the features undisclosed by Livingston.

Keyworth et al. disclose a communications user interface wherein a GUI displays a gallery of icons representative of certain individuals with whom the user communicates. While the icons may be a likeness of each face of the individuals, that likeness is not a "thumbnail" as the term is used in the specification or claims of the present application.

As defined in the present application, the term "thumbnail" refers to "a miniature representation of the page as it will look when it is printed, including representations of the content and formatting of the document" (pg. 21,

lines 18-21). The icons of Keyworth et al. are not miniatures of pages as they will look when they are printed. As held in *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 227 USPQ 657,666 (Fed. Cir., 1985), "each element of a claim is material." In the present application, the Examiner has failed to cite a reference or combination of references that include all of the claimed features.

Paragraph 5 of the Office Action:

Claims 57, 58, 60, 61, 63, 64, 66, and 67 are rejected as being obvious over Livingston in view of Keyworth et al. and further in view of Habib et al. The rejection is respectfully traversed for the reasons set forth above with respect to the rejection of Claims 56, 59, 62, 65, 68, 70 and 71, and further because the Examiner has not made any reference to an explicit teaching or suggestion in the art to motivate one of ordinary skill to combine the features of Habib et al. with the other references.

The Examiner is proposing that the motivation to combine Habib et al. with Livingston and Keyworth et al. is that the combination would allow all the page setup attributes to appear on the palette and would make it easier for users to control the attributes via the buttons. Again, the Examiner suggests that the motivation for the modification is that it is an improvement over the other reference.

Again, Applicant notes that the test for motivation is not merely that the combination would be an improvement over the primary reference, but that there was some explicit teaching or suggestion in art to motivate one of ordinary skill to combine elements so as to create same invention.

When addressing Claim 60, the Examiner suggests that it would have been obvious to use the pull down menu and dialog box of Habib et al. in the combination of Livingston and Keyworth et al. because "it would make it easier for users to control the attributes via the pull down menu and dialog box." Again, the Examiner mistakenly finds motivation in the fact that the present invention offers an advantage over the prior art. Applicant believes that the motivational test applied by the Examiner is incorrect, and that there is no motivation to one skilled in the art to modify the subject matter of Livingston and Keyworth et al. in view of the teachings of Habib et al.

Paragraph 6 of the Office Action:

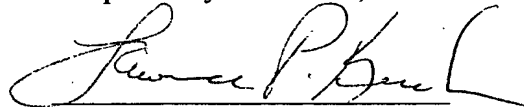
Claims 72-75 are rejected as being obvious over Livingston in view of Keyworth et al. and further in view of Conners. The rejection is respectfully traversed for the reasons set forth above with respect to the rejection of Claims 56, 59, 62, 65, 68, 70 and 71, and further because the Examiner has not made any reference to an explicit teaching or suggestion in the art to motivate one of ordinary skill to combine the features of Conners with the other references.

The Examiner is proposing that the motivation to combine Conners with Livingston and Keyworth et al. is because the combination would make it easier for users to control the attributes via the pull down menu and dialog box. Again, the Examiner suggests that the motivation for the modification is that it is an improvement over the other reference.

The test for motivation is not merely that the combination would be an improvement over the primary reference, but that there was some explicit teaching or suggestion in the art to motivate one of ordinary skill to combine elements so as to create same invention. The motivational test applied by the Examiner is incorrect, and that there is no motivation to one skilled in the art to modify the subject matter of Livingston and Keyworth et al. in view of the teachings of Conners.

In view of the foregoing, it is believed none of the references, taken singly or in combination, disclose the claimed invention. Accordingly, this application is believed to be in condition for allowance, the notice of which is respectfully requested.

Respectfully submitted,



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